

APPLICATION. NO. 09/933,768
REPLY TO OFFICE ACTION DATED SEPTEMBER 22, 2005

REMARKS/ARGUMENTS

These Remarks are responsive to the Office Actions mailed July 26, 2005 and September 22, 2005. Claims 1-5, 7, 9-12, 15-20, and 22-28 are currently pending in the present application. Claims 12 and 19 have been amended, claim 28 has been added and claim 14 has been canceled without prejudice or disclaimer of the subject matter set forth therein.

A. THE ALLOWABLE SUBJECT MATTER

The Office Action mailed September 22, 2005 ("Office Action"), on page 2, indicates that claim 27 has been allowed. Applicants thank the Examiner for allowing this claim.

Further, the Office Action, on page 2, objects to claim 14 as being dependent upon a rejected base claim and asserts that claim 14 would be allowable if rewritten in independent form. The Examiner is thanked for the indication that claim 14 would be allowable if rewritten in independent form. Applicants have amended independent claim 12 to include features of claim 14, and canceled claim 14. Hence, Applicant submits that claim 12 recites allowable subject matter.

B. THE REJECTION UNDER 35 U.S.C. § 101

The Office Action, on pages 2-3, rejects claims 1-5, 7, 9-11, 19-20 and 22-26 under 35 U.S.C. § 101 and asserts that the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The Office Action asserts that claims 1-5, 7, 9-11, 19-20 and 24-26 are directed to a system made up entirely of software and that the software must be tangibly embodied in order to define a functional interrelationship between the software and the computer upon which it is

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executing. Applicants respectfully submit that the Office Action has applied an incorrect test for determining whether claims 1-5, 7, 9-11, 19-20 and 24-26 recite statutory subject matter.

According to M.P.E.P. § 2106(IV)(B)(2)(a), "If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product." Because claims 1-5, 7, 9-11, 19-20 and 24-26 are system claims, according to M.P.E.P. § 2106(IV)(B)(2)(a), the appropriate test should have been to determine whether claims 1-5, 7, 9-11, 19-20 and 24-26 define a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination.

Independent claim 1 recites statutory subject matter because the system as recited in claim 1 defines a useful machine by identifying the physical structure of the machine in terms of its hardware and software combination. Specifically, claim 1 recites:

A system for tracking errors, the system residing on a user's desktop communicating with a central database over a network, the system comprising:
an error log including error recording tools for enabling the user to record an error;
error resolution tools for enabling the user to resolve the error; and error follow-up tools for enabling a user to follow up on resolved errors;
error reporting tools for enabling a user to generate error reports from the user's desktop, wherein the reporting tools comprise means for generating a plurality of customized reports and wherein the customized reports comprise a group error count report for providing the user with a volume of errors found at a particular point of quality review; and
communication means for enabling the user to transmit logged errors to the central database and to receive reports generated from errors logged in the central database. (emphasis added).

Because claim 1 recites a user's desktop, a central database, a network, an error log, error recording tools, error resolution tools, error follow-up tools, error reporting tools, means for

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generating a plurality of customized reports, and communication means, claim 1 defines a useful machine by identifying the physical structure of the machine in terms of its hardware and software combination. Hence, claim 1 recites statutory subject matter.

Dependent claims 2-7 and 9-11 depend from claim 1 and, by virtue of their dependency from claim 1, also recite statutory subject matter.

Independent claims 24-26 recite similar subject matter as claim 1. For at least similar reasons discussed above with respect to claim 1, claims 24-26 also recite statutory subject matter.

The Office Action further asserts that claims 19-20 and 22-23 are drawn to an algorithm that can be performed entirely by a human using solely a pencil and paper and as such do not meet the requirements for a statutory process.

Although Applicants do not acquiesce to the assertions in the Office Action regarding the statutory subject matter recited in claims 19-20 and 22-23, in an effort to advance prosecution of the application, claim 19 has been amended to more clearly recite statutory subject matter. According to M.P.E.P. § 2106(IV)(B)(2)(b)(ii), for subject matter of a process to be statutory, "the claimed process must be limited to a practical application of [an] abstract idea or mathematical algorithm in the technological arts." Further, according to the M.P.E.P., "a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible, and useful result, i.e., the method recites a step or act of producing something that is concrete, tangible, and useful. M.P.E.P. § 2106(IV)(B)(2)(b)(ii).

Amended claim 19 now recites "generating error resolution data based on the resolution details; and storing the error resolution data in a computer-implemented error log database." Claim 19 recites a statutory process because "generating error resolution data based on the

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resolution details” and “storing the error resolution data in an a computer-implemented error log database.” are steps or acts of producing something that is concrete, tangible, and useful. Hence, claim 19 recites a statutory process claim.

Claims 20 and 22-23 depend from claim 19 and, by virtue of their dependency from claim 19, also recite statutory subject matter.

In view of the above, Applicants respectfully request that the rejections under 35 U.S.C. § 101 be withdrawn.

C. THE REJECTIONS UNDER 35 U.S.C. § 103

1. The Rejection of Claims 12 and 15-18

The Office Action, on pages 3-8, rejects claims 12 and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,028,970 to DiPiazza in view of U.S. Patent No. 6,032,184 to Cogger et al. and in further view of The Microsoft Press Computer Dictionary, Third Edition. Applicants respectfully traverse this rejection.

As noted above, claim 12 has been amended to include subject matter indicated allowable by the Examiner. Hence, this rejection is rendered moot. Applicants therefore request that claim 12 be allowed.

Claims 15-18 depend from claim 12, and are allowable as being dependent from an allowable claim.

In view of the above, Applicants respectfully request that this rejection be withdrawn.

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2. The Rejection of Claims 19-20 and 22-23

The Office Action, on pages 6-8, rejects claims 19-20 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,028,970 to DiPiazza in view of U.S. Patent No. 6,516,055 to Bedeski et al. Applicants respectfully traverse this rejection.

Claim 19 has been amended to recite "locating an error incident number, wherein the error incident number is associated with a policy number." Neither DiPiazza nor Bedeski, alone or in combination, teaches or suggests that an "error incident number is associated with a policy number." Instead, DiPiazza teaches a method and apparatus for enhancing optical character recognition, while the Bedeski system is for providing an electronic interface between a telephone company's trouble report input system and its trouble report resolution system. This cited combination in no way teaches or suggests that an "error incident number is associated with a policy number." Accordingly, claim 19 is allowable over the combination of DiPiazza and Bedeski.

Claims 20 and 22-23 depend from claim 19, and are allowable as being dependent from an allowable claim.

D. CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action, and that the application is in condition for allowance.

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If the Examiner believes, for any reason, that a personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided below.

No fees are believed to be in connection with the filing of this Amendment. If it is determined that fees are due, the Commissioner is hereby authorized to charge such fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: **December 22, 2005**

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